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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/850,967	05/08/2001	John P. Miller	F-107	2930

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EXAMINER
GIBSON, RANDY W

ART UNIT	PAPER NUMBER
2841	

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/850,967	Applicant(s) MILLER ET AL.	
	Examiner Randy W. Gibson	Art Unit 2841	

-- The MAILING DATE of this communication appears on the cover sheet with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 August 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *45 and 49-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *45 and 49-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed August 7, 2003 have been fully considered but they are not persuasive. The applicant states in his response that "[w]ith respect to the commonly assigned `878 patent, it merely teaches of slowing down a mailpiece transport to accommodate for the setting cycle of a postage meter. The `878 patent has no teachings or suggestions regarding ... determining the postal break point is within a margin of error..." or "...stopping the mailpiece to weigh it again" [emphasis added]. However, the examiner notes that the applicant failed to address the fact that the commonly assigned '878 application teaches more than "merely ...slowing down a mailpeice transport to accommodate for the setting cycle of a postage meter." The applicant did not appear to address the following section of the '878 patent even though the applicant acknowledged that this section of the '878 patent was relied upon by the examiner in the rejection:

> "A substantial improvement, however, may be achieved in the average worst case weighing time by determining weights based on two successive count signals when the indicated weight is sufficiently far from the breakpoints in the postal rates. Thus, for example, assuming a necessary accuracy of one-thirty second of an ounce, if two successive count signals indicated the same weight between one-eight of an ounce and seven-eights of an ounce that indication could be accepted as a valid weight. When the indication was of a weight closer to the breakpoint three or more signals would be used to determine the weight in the conventional manner." Column 10, line 58 to column 11, line 2 [emphasis added]

Applicant's statement that the `878 patent "...merely teaches of slowing down a mailpiece transport to accommodate for the setting cycle of a postage meter" and that

the reference contains "...no teachings or suggestion" of " ...determining the postal break point is within a margin of error" apparently are not accurate statements regarding the prior art.

Since the '878 patent teaches that "determining the weight in the conventional manner" [Col. 11, lines 1-2] involves the step of " ...slowing down a mailpiece transport to accommodate for the setting cycle of a postage meter" [applicant's own admission], then it appears that the '878 patent indeed teaches the general idea "...to take more time to weigh a item of post if the postal break point is within the margin of error of the weighing mechanism that the item is being transported across." [examiner's action].

The examiner also notes that if the applicant wants to introduce his own testimony, as an expert in the art, as evidence of non-obviousness, then the applicant needs to file an affidavit or declaration setting forth the facts being asserted:

> Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See *MPEP* § 2129 and § 2144.03 for a discussion of admissions as prior art.
>
> The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness."). See *MPEP* § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration.
>
> ***MPEP* § 2145(I)** [emphasis added]

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 45, 49, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hubler et al (U.S. # 6,265,675 B1) in view of Freeman et al (U.S. # 4,742,878). Hubler et al discloses a method and apparatus for weighing mailpeices including a base (51), a forward driving mechanism (4), a weighing mechanism (7) connected to the base & driving mechanism (Figure 5), a guide mechanism (612) with a plurality of baffles (6121), a normal force component (62), and a structural pillar (6113).

Hubler et al shows the claimed invention except for temporarily stopping the transport of a mail piece across the weighing station if the postal break point is within the margin of error of the weighing mechanism. However, it is known in the art to take more time to weigh a item of post if the postal break point is within the margin of error of the weighing mechanism that the item is being transported across as shown by the example of Freeman et al (Col. 8, lines 34-49; Col. 9, line 65 to col. 11, line 2). It would have been obvious, therefore, to modify the control system of Hubler et al to temporarily stop the transport of a mail piece across the weighing station if the postal break point

was within the margin of error of the weighing mechanism, as taught by Freeman et al, to increase accuracy without sacrificing throughput.

4. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hubler et al (U.S. # 6,265,675 B1) in view of Freeman et al (U.S. # 4,742,878) as applied to claims 45, 49, and 51 above, and further in view of Tolson (U.S. # 5,326,938). Hubler et al discloses the claimed invention except they use one load cell instead of two. However, it has been held that a mere duplication of parts would have been obvious to the ordinary practioner unless there is evidence that some unexpected result is obtained. See *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960); and, *MPEP* §§ 716.01(c) & 2155.04(VI)(B). Furthermore, Tolson teaches that using two load cells to support a weighing conveyor was a known functional equivalent to an embodiment using just one load cell (Col. 4, lines 42-54), so it would have been obvious to the ordinary practioner to modify the device of Hubler et al to include two load cells. See *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982); and, *MPEP* §§ 2144.06 & 2144.07.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy W. Gibson whose telephone number is (703) 308-1765. The examiner can normally be reached on Mon-Fri., 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David S Martin can be reached on (703) 308-3121. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-5115.

Randy W. Gibson
Primary Examiner
Art Unit 2841